| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/645,645 | 08/24/2000 | Brian R. Woods | 17887-004900US | 3346 |

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| EXAMINER |
|---|
| BARQADLE, YASIN M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2153 | |

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _08 July 2003_ .

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-21_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-21_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## Response to Amendment

1.   The amendment filed on July 8, 2003 has been fully considered but are moot in view of the new ground(s) of rejection.

2.   Claims 1-21 are presented for examination.

### Double Patenting

3.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4.    Claims 1-21 are provisionally rejected under 35 U.S.C. 101

as claiming the same invention as that of claims 1-21 of

copending Application No. 09728524.  This is a provisional double

patenting rejection since the conflicting claims have not in fact

been patented.


### *Claim Rejections - 35 USC § 103*


The following is a quotation of 35 U.S.C. 103(a) which forms

the basis for all obviousness rejections set forth in this Office

action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains.  Patentability shall not be
> negatived by the manner in which the invention was made.


5.    Claims 1-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cotten USPN (6330590) in view of Pace et al

USPN (6460050).


As per claim 1, Cotten teaches a method for automatically

processing electronic mail, comprising:

      loading an electronic mail message [Col. 2, lines 18-27];

      removing non-textual information from the electronic mail

message [note: eliminating personalization and addressing portion

Col. 2, lines 18-27];

Although Cotten shows substantial features of the claimed invention, he does not explicitly show locating a first portion from the electronic mail message and generating a first code (digital id) smaller than the first portion and indicative of the first portion [Col. 3, lines 46-67 and Col. 4, lines 1-12].

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Cotten, as evidenced by Pace et al USPN. (6460050).

In analogous art, Pace et al disclose a system that identifies whether a piece of e-mil is Spam by generating digital IDs (codes) from portions of the body of the e-mail message. As a result the digital IDs contain a hashed data of variable length [Col. 4, lines 3-40].

Giving the teaching of Pace et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Cotten by employing the system of Pace et al in order to provide a content classification system that can identify any sort of text or binary data which resides on or is transmitted through a system in a an efficient and up-to-date manner [Col. 3, lines 8-27].

Pace et al further teach locating a second portion from the electronic mail message and generating a second code smaller than the second portion and indicative of the second portion [Col. 4, lines 3-40], [See also Cotton, Col. 3, lines 47-67 and Col. 4, lines 1-12 where the signature is coded in abbreviated format]; and

storing the first code and the second code [abstract and Col. 4, line 53 to col. 5, line 17].

As per claim 2, Pace et al teach the method for automatically processing electronic mail of claim 1, wherein the storing the first code and the second code comprises storing the first code and second code to semiconductor memory [Col. 2, lines 22-29].

As per claim 3, Pace et al teach method for automatically processing electronic mail of claim 1, wherein the locating the first portion uses a different algorithm than the locating a second portion [Col. 3, line 65 to col. 4, line 14; col. 6, lines 36-42].

As per claim 4, Pace et al teach method for automatically processing electronic mail of claim 1, further comprising:

locating a second through nth portions [digital ID generated may be multiple hashes and the hashing algorithm may performed on all or some portions of the body message [Col. 4, lines 6-14]; and

interrupting the locating the second through nth portions when a total number of portions reaches a predetermined count [Col. 6, lines 6 to col. 7. line 17].

As per claim 5, Cotten teaches method for automatically processing electronic mail of claim 1, wherein the non-textual

information includes at last one of header information, a subject line, an Internet protocol (IP) address, routing information, hypertext markup language information, and an embedded applet [Col. 3, lines 47-67].

As per claim 6, Cotten teaches method for automatically processing electronic mail of claim 1, further comprising removing everything from the electronic mail message except a message body [Col. 3, lines 59-67].

As per claim 7, Pace et al teach method for automatically processing electronic mail of claim 1, further comprising arranging the first code and the second code according to numerical value [the system utilizes a hashing process to produce digital IDs Col. 2, lines 22-34].

As per claim 8 and 15, claims include similar limitations of claims 1 and 5 above. Therefore, they are rejected with the same rationale

As per claims 9 and 16, Cotten teaches the method for automatically processing electronic mail further comprising removing non-textual information from the electronic mail message [Col. 3, lines 59-67].

As per claims 10 and 17, Cotten teaches the method for automatically processing electronic mail, wherein the non-textual

information includes at least one of header information, a
subject line, an internet protocol (IP) address, routing
information, hyper-text markup language information, and all
embedded applet [Col. 3, lines 47-67].

As per claims 11 and 18, Pace et al teach the method for
automatically processing electronic mail further comprising
interrupting the selecting the third number of portions from the
electronic mail message if the third number reaches a
predetermined count [Col. 6, lines 6 to col. 7. line 17].

As per claims 12 and 19, Pace et al teach the method for
automatically processing electronic mail further comprising
arranging the fourth number of codes according to a numerical
value [the system utilizes a hashing process to produce digital
IDs Col. 2, lines 22-34].

As per claims 13 and 20, Pace et al teach the method for
automatically processing electronic mail wherein each code is
smaller its respective portion [the system utilizes a hashing
process to produce digital IDs Col. 2, lines 22-34].

As per claims 14 and 21, Cotten teaches the method for
automatically processing electronic mail wherein generating the
plurality of codes includes processing the plurality of portions

with an algorithm selected from the group consisting of a checksum, a cyclic redundancy check [Col. 2, lines 28-38]. As for, processing plurality of portions with a hash algorithm [see Pace et al, col. 4, line 2-14].

## Conclusion

6.    The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-9717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-304-3900.